



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,466	07/09/2001	Stephen J. Lippard	MTV-033.01	5664

25181 7590 12/30/2002

FOLEY HOAG, LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BLVD
BOSTON, MA 02110

EXAMINER

CEPERLEY, MARY

ART UNIT	PAPER NUMBER
----------	--------------

1641

DATE MAILED: 12/30/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/901,466

Applicant(s)

LIPPARD ET AL.

Examiner

Mary (Molly) E. Ceperley

Art Unit

1641

-- The MAILING DATE f this communication appears on the c ver sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

a) Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, 20-30, and 48 drawn to 4'- or 4', 5'-substituted ligands wherein V is a Lewis base, classified in numerous subclasses of at least classes 562, 549, and 546; class 436, subclass 800.
- II. Claims 12-14, 31-33, and 49 drawn to 4'- or 4', 5'-substituted compounds wherein V is a member of a specific binding pair and a kit containing the compounds, classified in class 530, subclass 391.5; class 436, subclass 815.
- III. Claims 15-19, 34-38, drawn to 4'- or 4', 5'-substituted scaffolds wherein W is a functional group, classified in numerous subclasses of at least classes 560, 549, and 562.
- IV. Claims 39 and 40, drawn to metal coordination complexes of 4'-, or 4', 5'-substituted ligands, classified in class 556, subclass 118+.
- V. Claims 41-46, drawn to a method of detecting or quantifying a metal ion using a ligand wherein V is a Lewis base, classified in class 435, subclass 7.21.
- VI. Claim 47, drawn to a method of detecting a member of a specific binding pair wherein V is a member of a specific binding pair, classified, for example, in class 436, subclass 546.

b) The inventions are distinct, each from the other because of the following reasons:

i) Inventions **a)** III and II, **b)** I and II, and **c)** I and IV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate products are deemed to be useful as components of fluorescent inks or dyes and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this

Art Unit: 1641

is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

ii) Inventions *a)* II and VI and *b)* I and V are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the fluorescein derivatives of I could be used as components of a fluorescent ink or dye composition; the conjugates of II wherein the specific binding pair member is an antigen could be used as an element on the surface of an affinity chromatography column used to extract the corresponding antibody from a biological sample.

c) Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter requiring divergent searches in both the patent and technical literature, restriction for examination purposes as indicated is proper.

d) Claims 1-49 are generic to a plurality of disclosed patentably distinct species comprised of compounds containing multiple variables. Any particular combination of specific variable definitions may define a compound which is structurally and functionally different in nature from other compounds encompassed by the claims. For the election of any one of Inventions I-VI above, applicants are further required under 35 U.S.C. 121 to elect a single disclosed species even though this requirement is traversed. Should applicants traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner

Art Unit: 1641

finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

e) Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

f) Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

g) Applicants are advised that in accordance with the court decisions in *In re Ochiai*, {71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995)} and *In re Brouwer* {77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996)}, in the event that a product claim is found to be allowable, a method of use claim ***which is of the same scope as the allowed product claim*** may be rejoined with the allowed product claim.

h) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. (Molly) Ceperley whose telephone number is (703) 308-4239. The examiner can normally be reached from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached at (703) 305-3399. The fax phone number for responses to be filed BEFORE final rejection is (703) 872-9306. The fax phone number for responses to be filed AFTER final rejection is (703) 872-9307.

Questions which are NOT RELATED TO THE EXAMINATION ON THE MERITS, should be directed to **TC 1600 CUSTOMER SERVICE** at **(703) 308-0198**. Any inquiry of a general nature or relating to

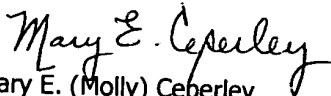
Application/Control Number: 09/901,466

Art Unit: 1641

Page 5

the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

December 26, 2002


Mary E. (Molly) Ceperley
Primary Examiner
Art Unit 1641